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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHUONG HUE HA and GLENN RAYMOND MCCLENDON III

Appeal 2008-4082
Application 10/101,838
Technology Center 3600

Decided:¹ March 5, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID
B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants seek our review of the Examiner's final rejection of claims 1-5 and 12-16 under 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

Appellants claim a table-driven accounting system that places all of the rules and controls pertaining to different types of accounting documents into user-configurable and modifiable tables, and uses the table-driven rules to create posting lines. Posting lines allow for accounting transactions to be verified and modified by the user before the transactions are updated to the accounting system files (Specification 1:[0002]). Claims 1, 4, and 12, reproduced below, are the only independent claims on appeal.

1. A computer-implemented apparatus comprising:
 - a posting line catalog storing posting lines electronically created from documents; and
 - a computer-implemented engine electronically rebuilding a journal from the stored posting lines.

4. A computer-implemented apparatus comprising:
 - journals electronically created from posting lines, the posting lines being electronically created from documents;
 - a posting line catalog storing the posting lines; and
 - a computer-implemented engine electronically rebuilding a respective journal of said journals from the stored posting lines in accordance with parameters

provided to the engine.

12. A computer-implemented apparatus comprising:
 means for storing posting lines electronically
 created from electronic documents; and
 means for electronically rebuilding a journal from
 the stored posting lines.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Marks	US 5,117,356	May 26, 1992
Micka	US 6,148,383	Nov. 14, 2000

1. Claims 1-5 and 12-15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Marks.
2. Claims 1-5 and 12-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Marks in view of Micka.

ISSUES

The Appellants argue that Marks does not disclose or suggest rebuilding a journal. The Examiner found that the rebuilding of a journal from stored posting lines is taught by Marks. Have the Appellants shown that the Examiner erred in finding that Marks discloses a computer-implemented engine electronically rebuilding a journal from stored posting lines?

The Appellants argue that Micka does not rebuild a journal in the manner claimed. The Examiner found that Micka discloses that a journal is constantly updated to include rebuilding a journal as claimed. The Examiner further found that it would be obvious to modify the journal system of Marks to include the feature to rebuild the journal from posting lines presently in use by causing all data to be held in a database until needed, because this would ensure the best data being populated into the journal. Have the Appellants shown that the Examiner erred in finding that the combination of Marks and Micka would have been obvious to one of ordinary skill in the art at the time of the invention and that the combination teaches a computer-implemented engine electronically rebuilding a journal from the stored posting lines?

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification teaches a computer-implemented engine electronically removing entries from the journal corresponding to a run date or time range, electronically accessing stored records in the posting line catalog corresponding to the run date or time range, and electronically rebuilding the respective journal from the accessed records (Specification 5).

2. Marks is directed to an automated recordkeeping and accounting system and in particular to such a system that provides current balances of all ledger accounts of a recordkeeping entity whenever data relating to an accountable transaction is entered and posted by the system (Marks, col. 1, ll. 11-16).
3. Marks teaches that after the temporary transaction record set is entered into the permanent transaction record file 30, the temporary transaction records in the physical storage spaces previously occupied by the set in the temporary transaction records file 28 are erased and the file control table 34 is updated to make the record labels for those records available for assembling a new temporary transaction records set (Marks, col. 15, ll. 34-41).
4. Micka is directed to a digital data storage system using a universal timer to perform asynchronous peer-to-peer data mirroring where primary and secondary controllers cooperatively perform periodic consistency checks according to the universal timer (Micka, col. 1, ll. 9-14).

PRINCIPLES OF LAW

We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment

appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”). The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere*

Co., 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court held that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at

1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

Rejection of claims 1-5 and 12-15 under 35 U.S.C. § 102(b) as anticipated by Marks.

The Appellants argue claim 4 separately.

The Examiner found some of the Appellants' arguments with respect to claim 4 not to be commensurate with the scope of the claims, including: (1) (Argument A) Rebuilding an existing journal that has been corrupted (Answer 5); (2) (Argument B) Storing information for later rebuilding of journal and rebuilding journal at later date (Answer 5); and (3) (Argument C) Rebuilding more than once (Answer 5-6). The Appellants do not contest these findings in the Reply Brief. We agree that the above arguments are not commensurate with the scope of the claims.

The Appellants argue that Marks does not disclose or suggest rebuilding a journal as recited, for example, in claim 4 (Br. 6). The Examiner found that Marks discloses a computer-implemented engine (citing Marks, item 12, 14; see column 4, lines 7-28) electronically rebuilding a final journal (citing Marks, item 30) from the posting lines (citing Marks, column 6, lines 5-14) (Answer 3). The Examiner further found that the rebuilding of a journal from stored posting lines is taught by Marks (Answer 6). The Examiner construed "rebuild" to mean "to build again" and "build" to mean construct. The Appellants do not contest this construction.

According to the Examiner, the entries TT1 TT2 TT3 in Marks thus are reconstructed by the journal data file 30. The Examiner found that by either definition, Marks reconstructs the data of temporary journal file 28 to the final journal file 30 (Answer 6). The Appellants argue that the permanent transaction record in Marks is only built once and therefore is not rebuilt. The Appellants also argue that by comparing Figures 5 and 6 of Marks, it can be seen that the temporary transaction records are different from the permanent transaction records. According to the Appellants, the constructing of the permanent transaction records data file 30 in Marks should not be considered as “rebuilding” the temporary transaction journal data file 28 (Reply Br. 3). We do not find this argument persuasive, because Marks teaches that the temporary transaction record set is entered into the permanent transaction records file (Finding of Fact 3).

Moreover, there is nothing in any of the independent claims that requires the journal to have a record that is the same as the record from which it is rebuilt. In fact, the Specification makes clear that the Appellants contemplated a computer-implemented engine electronically removing entries from the journal corresponding to a run date or time range, electronically accessing stored records in the posting line catalog corresponding to the run date or time range, and electronically rebuilding the respective journal from the accessed records (Finding of Fact 1). The Specification thus teaches rebuilding a journal by removing entries for a certain time period and replacing them with other entries for the same time period. The Appellants therefore have not shown the Examiner erred in rejecting claim 4 as anticipated by Marks.

The Examiner further found that the Appellants have not detailed the difference between certain claimed features and Marks, but merely stated that Marks does not disclose those claimed features, in particular, (1) (Argument D) (Claims 2 and 15) the engine rebuilds the journal in accordance with parameters provided to the engine (Answer 8); (2) (Argument E) (Claims 3 and 5) the engine removes entries from the journal corresponding to the parameters, accesses stored posting lines corresponding to the parameters, and rebuilds the journal from the accessed posting lines (Answer 8); and (3) (Argument F) (Claims 1, 12, 13, and 14) a posting line catalog storing posting lines electronically created from documents; and a computer-implemented engine electronically rebuilding a journal from the stored posting lines (Answer 8). The Appellants respond in the Reply Brief that their arguments in the Brief are sufficient to overcome the rejections of claims 1-3, without explicitly challenging the Examiner's above findings with respect to Arguments D-F. With respect to claims 1-3, 5, and 12-15, the Appellants rely on their arguments against claim 4, which are equally unpersuasive here. Appellants therefore have not shown that the Examiner erred in rejecting claims 1-3, 5, and 12-15.

Rejection of claims 1-5 and 12-15 under 35 U.S.C. 103(a) as unpatentable over Marks in view of Micka.

The Examiner found that Marks teaches the invention as disclosed in the above rejection, but also rejected claims 1-5 and 12-15 as obvious over Marks in

view of Micka, because the Appellants argued that Marks does not teach rebuilding a file from temporary storage. Specifically, the Examiner found

However, Micka et al. disclose this feature in that a journal is constantly updated to include temporary data. It would be obvious to modify the journal system 28 of Marks to include this feature to rebuild the journal 30 from posting lines presently in use by causing all data to be held in a database until needed because this would insure the best data being populated into the journal.

(Answer 4).

The Appellants restate all of the arguments made against the anticipation rejection over Marks. Those arguments are equally unpersuasive in the context of the obviousness rejection over Marks in view of Micka. Because we found above that the Appellants have failed to show that the Examiner erred in rejecting claims 1-5 and 12-15 as anticipated by Marks, those claims therefore also would be obvious over Marks alone, and the teachings of Micka are unnecessary for the Examiner to establish a *prima facie* case of obviousness over Marks in view of Micka. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for anticipation is the epitome of obviousness. *See In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974); and *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982).

Moreover, the Appellants arguments against Micka also are not persuasive of error in the Examiner's obviousness rejection. The Appellants argue that Micka maintains primary and backup copies of data to protect against inadvertent data loss, data corruption, disaster, etc. According to the Appellants, if data is lost,

Micka simply resurrects the data by copying it from a secondary site, and describes a copy of the source data to be a “mirror,” which is always “consistent” with the source data. Appellants further argue that Micka would not rebuild a journal from stored posting lines in accordance with parameters provided to the engine, and instead would maintain a mirror copy of the journal to be obtained if the journal was lost (Br. 10-11).

The Examiner noted that the Appellants previous argument that Marks does not disclose rebuilding a file from temporary data storage resulted in the inclusion of the 103 rejection in view of Micka, which was not relied upon for the rebuilding of a journal in the entire manner as claimed. According to the Examiner, Micka discloses that a journal is constantly updated to include temporary data. The Examiner further found that it would be obvious to modify the journal system 28 of Marks to include this feature to rebuild the journal 30 from posting lines presently in use by causing all data to be held in a database until needed, because this would ensure the best data being populated into the journal (Answer 9).

The Appellants’ argument is not persuasive because the Appellants are attacking the references individually rather than the combination asserted by the Examiner. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in finding that Marks discloses a computer-implemented engine electronically rebuilding a journal from stored posting lines. We conclude that the Appellants have not shown that the Examiner erred in finding that the combination of Marks and Micka would have been obvious to one of ordinary skill in the art at the time of the invention and that the combination teaches a computer-implemented engine electronically rebuilding a journal from the stored posting lines.

DECISION

The decision of the Examiner to reject claims 1-5 and 12-15 under 35 U.S.C. § 102(b) as anticipated by Marks is affirmed. The decision of the Examiner to reject claims 1-5 and 12-15 under 35 U.S.C. § 103(a) as unpatentable over Marks in view of Micka is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

JRG

Appeal 2008-4082
Application 10/101,838

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